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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

DENNIS P. CURRAN et al.

Serial No. 10/655,916

Filed: September 5, 2003

Art Unit: 1625

Examiner: BA K. TRINH

Atty Dock No.: 02-028

ANALOGS OF DISCODERMOLIDE AND
DICTYOSTATIN-1, INTERMEDIATES
THEREFOR AND METHODS OF
SYNTHESIS
THEREOFPittsburgh, Pennsylvania 15219
April 21, 2005Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

CERTIFICATE OF FAXING

I hereby certify that this correspondence and any document referred to as enclosed herewith are being faxed to the Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 at the following fax number on the date set forth below:

(703) 872 9306

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*Henry E. Bartony, Jr.*Henry E. Bartony, Jr.,
Registration No 34, 772

April 21, 2005

Dated

NO COVER SHEET
TOTAL PAGES: 3RESPONSE TO RESTRICTION REQUIREMENT

This Response to Restriction Requirement is in response to the Office Action dated March 22, 2005.

Serial No. 10/655,916
Attorney Docket No. 02-028

REMARKS

In the Office Action dated March 22, 2005, the Examiner required restriction to one of the following asserted inventions under 35 U.S.C. Section 121:

- I. Claims 1-3, 28-33, drawn to a macrolactone, classified in class 549, subclass 271.
- II. Claims 4-13, drawn to acid ester, classified in classes 560,562, subclasses various.
- III. Claims 14-15, 19-22, drawn to ether, classified in class 568, subclass 579.
- IV. Claims 16-18, drawn to pyran, classified in class 549, subclass 416.
- V. Claims 23-27, drawn to dioxane, classified in class 549, subclass 369.

Specifically, the Examiner asserted that:

The inventions are distinct, each from the other because: They are drawn to distinct groups based on their recognized divergent subject matter as shown by their distinct chemical structures and different classifications. A search of one group is not required for the search of the other group. A reference of one group would not suggest and/or render the other group obvious in the absence of the secondary teachings. Thus, the restriction requirement as indicated is deemed proper.

A telephone call was made to Mr. Henry Bartony on 16 March, 2005 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143). Applicant is also required to elect a singled disclosed species from the elected group for examination.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Applicants hereby elect Claims 1-3, 28-33 of Group I set forth by the Examiner with traverse.

In light of the above election and remarks, Applicants respectfully requests that the Examiner indicate the allowability of the claims and arrange for an official Notice of Allowance to be issued in due course.

Respectfully submitted,

DENNIS P. CURRAN et. al.

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